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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,145	07/22/2003	Stephen W. Boyd	004-001-C1	8267
32746	7590	12/10/2008		
HOEKENDIJK & LYNCH, LLP			EXAMINER	
P.O. BOX 4787			NGUYEN, VI X	
BURLINGAME, CA 94011-4787			ART UNIT	PAPER NUMBER
			3734	
			MAIL DATE	DELIVERY MODE
			12/10/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/625,145

Applicant(s)

BOYD, STEPHEN W.

Examiner

Victor X. Nguyen

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16 and 28-35 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 16 and 28-35 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. The request filed on 9/5/2008 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/625,145 is acceptable and a RCE has been established. An action on the RCE follows. Furthermore, the Terminal Disclaimer is also acknowledged.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16 and 28-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In **claims 16 and 28**, the disclosure filed on 7/22/2003 does not describe "the material removing element *being positioned beneath the cage*". Clarification is requested.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16, 28-30 and 33 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Kleshinski (6,245,012).

Kleshinski discloses in figures 1, 3, a device for removing material from a vascular site having the limitations as recited in claims 16 and 28, including: a cage (10 or 40) has a plurality of openings (the openings occur at 18) and has an inner surface, the openings are formed by rigidly connected elements (16), where a sheath (34) is retractable relative to the cage to permit the cage to expand, and where a material removing element (14) positioned within the cage that is capable of removing the material extending into the openings, and where the material removing element is inherently movable along the inner surface of the cage to remove the material extending into the openings, where the cage is being releasable (see col. 6, lines 20-24) so the cage is able to be left within the patient. Kleshinski is silent regarding the material removing element being positioned beneath the cage. It would have been obvious to one having ordinary skill in the art at the time the invention was made to reverse the position of stent 14 of being positioned beneath the cage, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167. The examiner notes that the limitation "the material removing element being positioned beneath the cage and *being movable along the inner surface of the cage to remove the material extending into the openings* " (a functional limitation), Thus, a reference needs not show the structure of the recitation in order to meet the claim language but rather the reference needs only be

capable of being used with such structure. (see MPEP 2111.04, MPEP 2112.01 and MPEP 2106).

As to claims 29-30, where elements 16 can be deformed within an elastic range (these resilient wires can be interpreted broadly that these wires can be characterized as deformed within the elastic range of material when moving from the expanded position to the collapsed position. As to claim 33, where the cage forms 2-10 openings (see col.5, lines32-47).

Claims 31-32 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Kleshinski in view of Fearnot (5,100, 423).

Kleshinski teaches all limitations substantially as claimed except a bag positioned to receive the material. Fearnot teaches the bag or net (see figure 8, element 202) in order to capture debris or matter from the bag or the filter. It would have been obvious to one having ordinary skill in the art at the time the invention to modify Kleshinski by adding the bag or the net as taught by Fearnot in order to capture debris or matter from the bag or the filter.

Claims 34-35 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Kleshinski (6,245,012)

Kleshinski discloses the invention substantially as claimed. Kleshinski is silent regarding the openings of the cage have a length of at least 1 mm and the openings of the cage have a size of at least 0.5 mm. Regarding claims 34-35, the device could make the openings of

the cage have a length of at least 1 mm and the openings of the cage have a size of at least 0.5 mm as best seen in fig.1. In the alternative, it has been held that changes in size only require routine skill in the art.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the device with the openings of the cage have a length of at least 1 mm and the openings of the cage have a size of at least 0.5 mm and a minor modification of Kleshinski's device would adopt the same for use under various conditions of service, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re. Aller, 220F, 2d 454, 105 USPQ 233.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ho Jackie can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/
Primary Examiner, Art Unit 3734

/Victor X Nguyen/
Examiner
Art Unit 3734

VN